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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/767,330	01/22/2001	Scott Thomas Molloy	14013-29US	9338
20575	7590	01/31/2008	EXAMINER	
MARGER JOHNSON & MCCOLLOM, P.C. 210 SW MORRISON STREET, SUITE 400 PORTLAND, OR 97204			SAM, PHIRIN	
ART UNIT		PAPER NUMBER		
2619				
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01/31/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/767,330	MOLLOY, SCOTT THOMAS	
Examiner	<b>Art Unit</b>		
Phirin Sam	2619		

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 21 November 2007.

2a)  This action is **FINAL**.                    2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 1-30 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-8, 10-15, 17, 21, 22 and 25-30 is/are rejected.

7)  Claim(s) 9, 16, 18-20, 23 and 24 is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on 22 January 2001 is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

PHIRIN SAM  
PRIMARY EXAMINER

**Attachment(s)**

1)  Notice of References Cited (PTO-892) **PRIMARY**  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date

4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_ .

5)  Notice of Informal Patent Application

6)  Other: \_\_\_\_ .

## DETAILED ACTION

### *Claim Objections*

1. Claim 21 is objected to because of the following informalities:

**Regarding claim 22**, lines 1-2, “A computer readable medium having stored therein computer readable program code comprising instructions for performing the following steps:” is unacceptable because it is not known what device executes these instructions. Therefore, the appropriate correction is required. For example, “A computer readable medium having stored therein computer readable program code comprising instructions **executed by a processor** for performing the following steps:”

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 2, 5, 6, 10-15, 17, 21, 22, and 25-28 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent 6,330,070 (hereinafter referred as “Toyoda”).

**Regarding amended claims 1, 5, and 6**, Toyoda discloses an advanced research projects agency (ARPA)-Internet network (data communication network) access/service provider device comprising:

a fax gateway including (see Figs. 1 and 2, element 14),

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- (a) a storage device for storing an e-mail message received from an e-mail sender for transmission to a fax recipient through a packet switching network, the stored e-mail message to be converted to a fax document for transmission thereof to the fax recipient having access to a fax device (see Figs. 1 and 2, elements 23, 25, col. 2, lines 59-67, and col. 3, lines 1-13);
- (b) at least one the modem device for transmitting the fax document to the fax recipient through a public switching network, wherein a fax number designating the fax recipient is obtained of separately from the e-mail (see Fig. 2, element 28, col. 3, lines 13-15).

**Regarding amended claim 2**, Toyoda discloses an Advanced research projects agency (ARPA)-Internet network access/service provider device comprising:

a fax gateway including (see Figs. 1 and 2, element 14)

- (a) a storage device for storing an e-mail message received from an e-mail sender for transmission to a fax recipient through a packet switching network, the stored e-mail message to be converted to a fax document to transmission thereof to the fax recipient having access to a fax device (see Figs. 1 and 2, elements 23, 25, col. 2, lines 59-67, and col. 3, lines 1-13);
- (b) at least one fax modem device for transmitting the fax document to the fax recipient through a public switching network, where a fax number designating the fax recipient is obtained separately from the e-mail (see Fig. 2, element 28, col. 3, lines 13-15).
- (c) where the storage device is enabled to store a the fax number, the fax number associated with the fax device of the fax recipient, the fax number to be used to establish a call for the transmission of the fax document (see Figs. 2, 3, and 5b col. 3, lines 41-49, 57-62, and col. 5, lines 16-27).

**Regarding amended claim 10**, Toyoda discloses the fax gateway is coupled to the public switching telephone network (see Fig. 1, col. 2, lines 50-56).

**Regarding claim 11**, Toyoda discloses the fax gateway is coupled to the public switching telephone network through a digital communications link (see Fig. 1, col. 2, lines 50-56).

**Regarding amended claim 12**, Toyoda discloses the fax gateway is coupled to the packet switching network through a digital communications link (see Fig. 1, col. 2, lines 50-56).

**Regarding amended claims 13-15**, Toyoda discloses the storage device is a computer system having a conversion program to convert the e-mail message to a fax document (see Figs. 2 and 3, col. 3, lines 12-14, and col. 5, lines 5-15).

**Regarding amended claim 17**, Toyoda discloses a method for sending and receiving e-mail messages using a fax device comprising:

- (a) receiving an e-mail message through a data communications network from an e-mail sender (see Fig. 1, col. 2, lines 57-59);
- (b) converting the e-mail message into a fax document (see Fig. 1, col. 2, lines 59-64);
- (c) retrieving a destination fax number of a fax recipient separate from the e-mail message (see Fig. 3, col. 3, lines 41-49);
- (d) transmitting the fax document to the fax recipient thereby enabling the fax recipient to receive e-mail messages without access to the data networking network (see Figs. 1 and 7, col. 4, lines 27-67, and col. 5, lines 1-27).

**Regarding amended claim 21**, Toyoda discloses a computer readable medium having stored therein computer readable program code comprising instructions for performing the following steps:

- (a) receiving an e-mail message, from through a data communications network (see Fig. 1, col. 2, lines 57-59);
- (b) converting the e-mail message into a fax document (see Fig. 1, col. 2, lines 59-64);
- (c) retrieving a destination fax number of a fax recipient separate from the e-mail message (see Fig. 3, col. 3, lines 41-49);
- (d) transmitting the fax document to a the fax recipient thereby enabling the fax recipient to receive e-mail messages without access to the data networking network (see Figs. 1 and 7, col. 4, lines 27-67, and col. 5, lines 1-27).

**Regarding amended claim 22**, Toyoda discloses a device comprising:

- (a) means for receiving an e-mail message, from through a data communications network (see Fig. 1, col. 2, lines 57-59);
- (b) means for converting the e-mail message into a fax document (see Fig. 1, col. 2, lines 59-64);
- (c) means for retrieving a destination fax number of a fax recipient separate from of the e-mail message (see Fig. 3, col. 3, lines 41-49);
- (d) means for transmitting the fax document to a the fax recipient thereby enabling the fax recipient to receive e-mail messages without access to the data networking network (see Figs. 1 and 7, col. 4, lines 27-67, and col. 5, lines 1-27).

**Regarding claims 25 and 27,** Toyoda discloses the ARPA-Internet network access/service provider device is enabled to obtain the fax number based, at least in part, on a look-up of an intended recipient of the e-mail message (see Figs. 5b-7, col. 3, lines 57-67, and col. 4, lines 13-49).

**Regarding claims 26 and 28,** Toyoda discloses the intended recipient of the e-mail message is identified in a To field of the e-mail message (see Figs. 3 and 5b, col. 3, lines 21-38, 57-67).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 3, 4, 7, 8, 29, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,330,070 (hereinafter referred as “Toyoda”) in view of US Patent 6,417,930 (hereinafter referred as “Mori”).

**Regarding amended claims 3 and 4,** Toyoda discloses an advanced research projects agency (ARPA)-Internet network access/service provider device comprising:

a fax gateway including

(a) a storage device for storing an e-mail message received from an e-mail sender for transmission to a fax recipient through a packet switching network, the stored e-mail message to be converted to a fax document for transmission thereof to the fax recipient having access to a fax device (see Figs. 1 and 2, elements 23, 25, col. 2, lines 59-67, and col. 3, lines 1-13);

(b) at least one lax modem device for transmitting the fax document to the fax recipient through a public switching network, where a fax number designating the fax recipient is obtained separately from the e-mail (see Fig. 2, element 28, col. 3, lines 13-15).

Toyoda does not disclose the storage device is a time-of-day for specifying a range of time during which the fax document is transmitted. Mori discloses the storage device is the time-of-day for specifying a range of time during which the fax document is transmitted (see Fig. 4, col. 7, lines 50-67, col. 8, lines 1-8). At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the time-of-day for specifying a range of time during which the fax document is transmitted teaching by Mori with Toyoda. The motivation for doing so would have been to provide to analyze the received e-mail to determine if it is relay transmission mail read on abstract. Therefore, it would have been obvious to combine Mori and Toyoda to obtain the invention as specified in the claim 3.

**Regarding amended claims 7, 8, claims 29, and 30,** Toyoda does not disclose the assigns an e-mail address to the fax recipient, the e-mail address being associated with the fax number and where the fax cover page includes a destination field extracted from the fax recipient e-mail address. However, Mori discloses the assigns the e-mail address to the fax recipient, the e-mail address being associated with the fax number and where the fax cover page includes a destination field extracted from the fax recipient e-mail address (see Fig. 4, col. 7, lines 50-67, and col. 8, lines 1-8). At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine xxx teaching by Mori with Toyoda. The motivation for doing so would have been to provide to analyze the received e-mail to determine if it is relay

transmission mail read on abstract. Therefore, it would have been obvious to combine Mori and Toyoda to obtain the invention as specified in the claims 7, 8, 29, and 30.

***Allowable Subject Matter***

6. Claims 9, 16, 18-20, 23, and 24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

7. Applicant's arguments with respect to claims 1, 10-15, 21, and 22 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

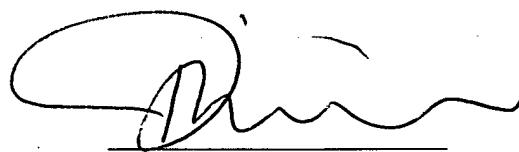
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phirin Sam whose telephone number is (571) 272-3082. The examiner can normally be reached on Increased Flexitime Policy (IFP) Program.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jay Patel can be reached on (571) 272 - 2988. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Respectfully submitted,

Date: January 29, 2008



**PHIRIN SAM**  
**PRIMARY EXAMINER**